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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,684	11/17/2003	Laurence M. McKinley	51013/JWP/M844	4554
23363	7590	10/13/2006	EXAMINER	
CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068			O'CONNOR, CARY E	
			ART UNIT	PAPER NUMBER
			3732	
DATE MAILED: 10/13/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,684

Applicant(s)

MCKINLEY, LAURENCE M.

Examiner

Cary E. O'Connor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004 and 15 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7-15-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION***Claim Rejections - 35 USC § 112***

Claims 17-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 17, lines 6-7, the passage "the angle between the shaft and the handle of the axis" is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (4,049,000). Williams shows a nerve root retractor and sucker 10 comprising a handle 16, and a nerve root retractor/sucker shaft 14 having proximal and distal open end and defining a central passage therebetween. The proximal end of the shaft is connected to the distal end of the handle and the axis along the distal end of the shaft forms an angle of less than 180 degrees with the axis of the handle (see Figure 1). A suction source is in fluid communication with the distal opening of the shaft wherein both the handle and the shaft define a

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suction fluid path between the suction source and the distal opening. At least one suction control vent 20 is disposed in the handle. The retractor/sucker also comprises a retractor blade 24 disposed at the distal end of the shaft. As to claim 3, the handle and the shaft define a hollow passage (Figure 6). As to claim 11, the angle claimed falls in the range taught in column 3, lines 50-52).

Claims 1, 3, 4, 7, 8, 12, 14, 16-19, 21, 23, 24, 27, 28, 32 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Suddaby (2004/0143164). Suddaby shows a nerve root retractor and sucker comprising a handle 12, and a nerve root retractor/sucker shaft 12 having proximal and distal open end and defining a central passage therebetween. The proximal end of the shaft is connected to the distal end of the handle and the axis along the distal end of the shaft forms an angle of less than 180 degrees with the axis of the handle (see Figure 7). A suction source is in fluid communication with the distal opening of the shaft wherein both the handle and the shaft define a suction fluid path between the suction source and the distal opening. At least one suction control vent 28 is disposed in the handle. The retractor/sucker also comprises a retractor blade 18 disposed at the distal end of the shaft (paragraph 0019). As to claim 3, the handle and the shaft define a hollow passage. Regarding claims 7 and 27, note that the shaft may be formed of plastic (paragraph 0021). As to claims 8, 14, 28 and 34, the shaft may be flexible (paragraph 0021) and is thereby malleable at room temperature. As to claims 16-19, the angle between the handle and the shaft may be varied because the shaft is flexible. As to claims 12 and 32, note the grooves 34 on the handle for improving gripping.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 5, 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (4,049,000) in view of Leffler (3,516,160). Williams does not show two vents in the handle and does not disclose that the shaft is detachably connected to the handle. The shaft of Williams is not variable in length or width. Leffler show a suction device comprising a handle 11 having two vents 20. Also, the shaft 22 is detachably connected to the handle. The length of the shaft is inherently variable because it is slidable within the handle (column 3, lines 33-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the handle of Williams with two vents as taught by Leffler, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It would have also been obvious to one of ordinary skill to form the retractor/sucker of Williams so that the shaft is removable from the shaft (thereby making the length variable), as taught by Leffler, so that the shaft may be disposable. Williams as modified by Leffler discloses the claimed invention except for the vents having different diameters. It would have been an obvious matter of design choice to form the vents with

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different diameters, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (4,049,000). Williams discloses the claimed invention except for the specific lengths of the shaft. It would have been an obvious matter of design choice to form the shaft with lengths specified by the claims, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suddaby (2004/0143164) in view of Folco et al (5,743,736). The shaft of Suddaby is not connected to the handle by a ball and socket joint. Folco shows a suction device wherein the shaft is connected to the handle 12 by a ball and socket joint. This socket joint enables the shaft to be bent at a desired angle to maintain that position until force is applied to the shaft. I would have been obvious to one of ordinary skill in the art at the time the invention was made to form the shaft of Suddaby with a ball and socket joint, as taught by Folco, so that the angel of the shaft relative to the handle may be adjusted to a desired shape.

Claims 22, 25, 26, 35 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suddaby (2004/0143164) in view of Leffler (3,516,160). Suddaby does not show two vents in the handle and does not disclose that the

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shaft is detachably connected to the handle. The shaft of Suddaby is not variable in length or width. Leffler show a suction device comprising a handle 11 having two vents 20. Also, the shaft 22 is detachably connected to the handle. The length of the shaft is inherently variable because it is slidable within the handle (column 3, lines 33-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the handle of Suddaby with two vents as taught by Leffler, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It would have also been obvious to one of ordinary skill to form the retractor/sucker of Suddaby so that the shaft is removable from the shaft (thereby making the length variable), as taught by Leffler, so that the shaft may be disposable. Suddaby as modified by Leffler discloses the claimed invention except for the vents having different diameters. It would have been an obvious matter of design choice to form the vents with different diameters, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suddaby (2004/0143164). Suddaby discloses the claimed invention except for the specific lengths of the shaft and angles between the shaft and the handle. It would have been an obvious matter of design choice to form the shaft with lengths specified by the claims, since such a modification would have involved a

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mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Suddaby discloses the claimed invention except for the angle between the distal end of the shaft and the handle being 135 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form a angle of 135 degrees between the distal end of the shaft and the handle, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (4,049,000) in view of Cise et al (6,129,547). Williams shows the claimed invention, *supra*, except for a plurality of shafts wherein the angle, length and width are different. Cise shows a suction system having a handle 20 and a plurality of shafts. Particularly, shafts 44 and 48 have different angles, lengths and widths thereby enabling a single handle to be used with different shafts according to the need. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Williams with a plurality of detachable shafts having different angles, lengths and widths, as taught by Cise, in order to enable a single handle to be used with different shafts according to the need.

Claim Objections

Claim 12 is objected to because of the following informalities: In line 2, "grip" should be changed to --slip--. Appropriate correction is required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "68" has been used to designate two different elements in Figure 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 66 (page 10, line 8).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 571-272-4715. The examiner can normally be reached on M-Th 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cary E. O'Connor
Primary Examiner
Art Unit 3732

ceo